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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,782	09/23/2005	Pieter Hildegardus Berben	4818	1536
48227	7590	09/25/2008	EXAMINER	
BASF CATALYSTS LLC 100 CAMPUS DRIVE FLORHAM PARK, NJ 07932				HAILEY, PATRICIA L
ART UNIT		PAPER NUMBER		
1793				
NOTIFICATION DATE			DELIVERY MODE	
09/25/2008			ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/531,782	BERBEN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	PATRICIA L. HAILEY	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 10 July 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 27-42 is/are pending in the application.  
 4a) Of the above claim(s) 27-33 and 40-42 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 34,35 and 37-39 is/are rejected.  
 7) Claim(s) 36 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 04/18/2005.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

*Election/Restrictions*

1. Applicant's election of Group III, claims 34-39 in the reply filed on July 10, 2008, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 27-40 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected process of using a catalyst (claims 33 and 40-42) and to a nonelected catalyst (claims 27-32), there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on July 10, 2008.

Claims 34-39 are under consideration by the Examiner.

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.  
2. Ascertaining the differences between the prior art and the claims at issue.  
3. Resolving the level of ordinary skill in the pertinent art.  
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. *Claims 34, 35, 37, 38, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent No. 1 101 530 (hereinafter "the European Patent"), Applicants' submitted art.*

The European Patent teaches a catalyst comprising nickel, silica, alumina, and magnesium, each present in weight percentages which correspond to the atomic ratios recited in **claims 34, 37, and 38**. See Table 1 of the European Patent, as well as paragraph [0015].

With respect to **claim 35**, the European Patent teaches that the catalyst, in powder form, exhibits suitable particle sizes between 1 and 1000  $\mu\text{m}$ ; see paragraph [0019] of the European Patent.

With respect to claim 39, the European Patent teaches that Patentees' catalyst can be prepared by coprecipitation, which comprises precipitating the catalyst components, recovering the coprecipitated material from the precipitation liquid, and further treating, which may include calcination, passivation (considered to read upon the limitation "coated with a protective layer"), and reduction. See paragraphs [0014]-[0017] of the European Patent, as well as Example 3.

The European Patent does not explicitly disclose the nickel surface area of the catalyst, as instantly claimed. However, because the European Patent teaches a catalyst having a comparable particle size, and having the same or similar components as that respectively claimed, said components being present in the same or similar atomic ratios, it would have been obvious to one of ordinary skill in the art at the time the invention was made to reasonably expect the catalyst disclosed in the European Patent to exhibit a nickel surface area comparable to that respectively claimed, absent the showing of convincing evidence to the contrary.

*Allowable Subject Matter*

7. *Claim 36 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.*
8. The following is a statement of reasons for the indication of allowable subject matter:

The European Patent does not teach or suggest the nickel to silicon atomic ratio recited in claim 36. The percentage ranges for nickel and silica disclosed in this reference correspond to atomic ratios that fall outside the ranges recited in claim 36.

*Priority*

9. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Applicants' Priority Document was filed on April 18, 2005.

*Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICIA L. HAILEY whose telephone number is

(571)272-1369. The examiner can normally be reached on Mondays-Fridays, from 7:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1700 Receptionist, whose telephone number is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/PATRICIA L. HAILEY/  
Examiner, Art Unit 1793  
September 22, 2008